

SUMMARY

After entry of this Request for Reconsideration, claims 271-357 will remain pending in this application.

REMARKS

Interview Summary:

Applicants thank the Examiner for the telephone conference of September 25, 2006 wherein the inadequacies of Sims were discussed.

Sims Fails To Anticipate The Present Claims Under 35 U.S.C. § 102:

Claims 271-357 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sims (U.S. Patent No. 5,012,041). Applicants traverse this rejection.

Sims teaches two overlapping electrically conductive wire meshes that facilitate electromagnetic shielding in an observation window of a medical MRI facility. Sims fails to disclose each and every element, either explicitly or inherently, of the present claims as required for an anticipatory rejection based on 35 U.S.C. § 102. Specifically, Sims fails to teach any reflectance values whatsoever, fails to teach the claimed reflectance of light of 0.04 or less, and fails to teach the use of only one grid layer in lieu of the Sims two-layered grids. Additionally, Sims fails to teach insect screening in a fenestration unit that permits ventilation therethrough as claimed. Thus, anticipation rejections based on Sims are improper and should be withdrawn as moot.

In rejecting the present claims under final, the Examiner stated:

Sims discloses two screens, one "fine" and the other "coarse", which are mounted in a window, i.e, fenestration unit, and which may be used without overlying glass. See column 3, lines 51-62. The fine screen, in one example, has opening dimensions of 0.018 in. in each direction and an element diameter of 0.005 in., each within the claimed parameters. Further, a coating, or "black die",

column 3, lines 47-50, is provided for glare relief. Since Sims et al provides the opening dimensions and element size recited as well as a black coating, it is clear, using Applicant's disclosure (see the table on page 13 of the specification) that the recited reflectance is achieved by Sims et al. While Sims provides two overlapping screens, the claims merely recite "insect screening in the fenestration unit" that has the recited properties. The insect screening 36, and in many cases the insect screening 38, each meet the recited properties.

This rejection is improper. For anticipation under 35 U.S.C. § 102, a reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (MPEP 706.02). Further, reliance on teachings provided only in an Applicants' specification to modify a reference to reach the claimed invention is improper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) (a rejection can take into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and cannot include knowledge gleaned only from the applicant's disclosure).

The final rejection based on Sims takes the position that some elements are explicitly disclosed by Sims and that some elements are inherently disclosed by Sims. For example, the Examiner asserts that the grids in Sims are mounted in a window and that the grid elements have opening sizes and element diameters that fall within the present claims. These elements are asserted to be explicitly disclosed by Sims (note references to column and line). Elements that are not explicitly disclosed in Sims are reasoned by the Examiner to be inherently disclosed. For example, the Examiner asserts that a reflectance of light of 0.04 or less is inherently disclosed in Sims by "using Applicants' disclosure" (note references to a page of Applicants' specification).

Explicit Disclosure:

Explicit disclosure in a reference is present when the asserted element is directly disclosed by the reference. For example, if a "red carburetor with two valves" is claimed, the

applied reference, in order to contain an explicit disclosure, must teach a two valve carburetor and provide that such carburetor is red. Here, Sims fails to disclose explicitly any reflectance values whatsoever, fails to disclose explicitly a reflectance of light of 0.04 or less as claimed, and fails to disclose explicitly the use of only one grid layer in lieu of the Sims two-layered grids. Since these items are not explicitly disclosed in Sims, to support a rejection based on anticipation, the Examiner presumably asserts that each of these items is inherently present in Sims. Applicants disagree.

Inherent Disclosure (Inherency):

In order to support a rejection based on inherency in an asserted reference, the missing descriptive matter necessarily must result, not “may” result, from the reference. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”)

Sims fails to disclose any reflectance values whatsoever. They have been implied instead as being inherently present. The Examiner asserts that:

Since Sims et al provides the opening dimensions and element size recited as well as a black coating, it is clear, using Applicant's disclosure (see the table on page 13 of the specification) that the recited reflectance is achieved by Sims et al.

This reasoning is incorrect. First, it is improper to use Applicants’ disclosure of one screen (here, TWP) to support an inherency rejection of entirely dissimilar two-layered grids (here, the two-layered grids of Sims). In fact, the screens described on page 13 of the Applicants’ disclosure

and the grids of Sims are too dissimilar to perform a proper inherency analysis. Table 1 on page 13 of the Applicants' disclosure shows transmittance and reflectance values of a 50 by 50 mesh TWP stainless steel screen of elements with 0.0012 inch diameters and with opening dimensions between elements of 0.0188 inch. Sims teaches two grids, with one of the two grids considered to be "comparatively fine" and the other grid considered to be "relatively coarse" [Sims, Col. 4, lines 25-27]. The relatively coarse grid of Sims preferably has a mesh count of about 24 elements per inch with an element diameter of 0.0075 inch, while the relatively fine grid preferably has a mesh count of about 43 elements per inch with an element diameter of 0.0050 inch [Sims, Col. 5, lines 31-39]. The two grids of Sims are individually over six times and over four times the diameter of the TWP screen from page 13 of Applicants' disclosure. Adding a coating increases even further the diameter of the elements. Applicants' disclosure elsewhere teaches that increasing the element width decreases the transmittance and increases the reflectance--further undermining the Examiner's inherency argument. Regardless of the actual thickness of either of the grids in Sims, the inherency argument advanced by the Examiner fails to meet the rigid standards of inherency since Sims fails to show that the missing descriptive matter (here reflectance as claimed) necessarily must result, not "may" result, from the reference.

Second, even if the inherency argument advanced by the Examiner found support in Applicants' disclosure (it doesn't), such alleged "inherent disclosure" fails still to provide the otherwise missing support for the Sims two-layered grid having reflectance of light of 0.04 or less as claimed. In order to succeed in an inherency argument, the Examiner would have to show that the two-layered grids of Sims necessarily would have a reflectance of light of 0.04 or less as claimed--not just provide conjecture about the reflectance values of the grids. This proposition

entirely lacks support since the grids shown in Sims are four to six times larger in element diameter than those relied upon from Applicants' disclosure.

Third, the only discussion of 'single layer metal grids' in Sims is in the section describing prior art, where Sims discusses the inability of a single grid layer to provide enough shielding. [Sims, Col. 1, lines 56-59]. Every embodiment of Sims discloses two-layered grids. Sims entirely fails to detail use of a single grid in place of his two-layered grids. It is well settled under these circumstances that it is not appropriate to pick and choose among disclosures in Sims as though they were isolated and independent in order to reject or deprecate the claimed invention. See In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Rather, one must consider the teachings of Sims as a whole. MPEP § 2141.02 and 2145. Accordingly, in order to accurately apply inherency to Sims using Applicants' disclosure as proposed by the Examiner, one would have to measure the reflectance of both the two-layered grids of Sims together, not either single layer grid. Since the increased diameter will likely reflect more light, and since there are two screens reflecting light, not just one, the resulting reflectance of the two-layered grids would likely be much higher than the TWP screens from Table 1 on page 13 of Applicants' disclosure. Regardless, the Examiner's assertions certainly would not support an inherency argument since it cannot be shown that the missing descriptive matter necessarily must result, not "may" result, from the reference. Accordingly, Sims fails to anticipate the present invention and rejections based on Sims should be withdrawn as moot.

Modification Of The Rejections Based On Sims From 35 U.S.C. § 102 To 35 U.S.C. § 103 Would Be Improper:

Sims teaches a double mesh system to attenuate electromagnetic interference (EMI) in shielded enclosures. The system includes two offset overlying meshes that preferably are

disposed between panes of glass to protect the delicate double mesh material from “accidental contact and damage.” [Sims, Col. 3, lines 54-56]. Sims further teaches that the panes of glass block sound and movement of air through the window. [Sims, Col. 3, lines 56-58]. Sims suggests removal of the panes of glass only under conditions where protection from accidental contact and damage of the delicate double mesh material is not required. [Sims, Col. 3, lines 58-60]. It thus is clear that the two-layered grids of Sims are delicate, fragile, and require protection against damage that would be caused by contact.

In contrast, Applicants’ claimed invention includes insect screening in a fenestration unit that permits ventilation therethrough. The insect screening serves as a physical barrier between an interior environment and an exterior environment inhabited by insects. This is an environment in which the screen material inherently must endure accidental contact and the potential for damage from, for instance, insects, blowing debris, humans, pets, and the like. Sims teaches that his delicate double mesh material must be sandwiched between panes of glass in such a scenario to protect the mesh from accidental contact and damage except where such protection is not required, such as where there is no potential for accidental contact. Thus, Sims teaches directly away from use of his two-layered grids under the very conditions recited in Applicants’ claims (insect screening in a fenestration unit that permits ventilation therethrough).

A practitioner in the insect screen art understands that physical forces, such as ventilation and contact by insects, pets, and other objects, typically encountered by an insect screen are too severe to be withstood by the Sims delicate two-layered grids without the protection of panes of glass. One of ordinary skill in the art would not be motivated to use the delicate two-layered grids of Sims in an environment in which an insect screen must function since an insect screen must be robust to withstand the very kind of contact that the Sims mesh requires protection

against. The pending claims are allowable over delicate mesh materials used in electromagnetic shielding applications, such as those taught by Sims.

Further, Sims teaches away from using only one screen in lieu of his two-layered grid. The Examiner proposes to use either one of two screens to reject the present claims. However, Sims itself teaches not to use one screen since a single grid layer fails to provide enough shielding [Sims, Col. 1, lines 56-59]. Thus, one of ordinary skill in the art would not be motivated to do what the Examiner proposes because it is contrary to what Sims itself teaches.

Further still, in order to reject the present claims under 35 U.S.C. § 103, Sims would have to be modified in a manner that would render it unsatisfactory for its intended purpose, which is improper. See MPEP 2143.01(V). If a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Withdrawal Of The Instant Final Rejection Is Consistent With The Examiner's Amendment And Statement Of Reasons For Allowance From The Parent Application:

The Final Rejection is inconsistent with the Examiner's position in the parent application that matured into U.S. Patent No. 6,880,612 ("the '612 Patent"). During prosecution of the '612 Patent, the Examiner proposed adding the language "in a fenestration unit that permits ventilation therethrough" to the independent claims drawn to insect screening. The Examiner then, by Examiner's Amendment, added this language to the independent claims and stated in an Examiner's Statement of Reasons for Allowance that the:

prior art does not disclose the screen material which has the structure recited which is used as an insect screen, which is claimed by way of reciting either the screen in combination with the structure of a fenestration unit or building structure or by reciting the method of using the screen material.

Sims was considered during prosecution of the '612 Patent. Sims did not teach insect screening "in a fenestration unit that permits ventilation therethrough" as claimed in the parent '612 Patent, and Sims does not teach insect screening "in a fenestration unit that permits ventilation therethrough" as claimed in the present claims. The inconsistent position between the Final Rejection and the prosecution of the parent '612 Patent can and should be remedied by withdrawing the instant Final Rejection.

Response To Comments Regarding Information Disclosure Statements (IDS):

The Final Office Action dated September 12, 2006 states:

Regarding the IDS's in this case, such are considered excessive and largely have been not considered. Many references are web sites that do not qualify as prior art since no date is provided other than the date they were printed off the internet. Court cases up to 989 pages long have been submitted as prior art. Catalogs up to 181 pages long have been submitted, one of which contains "galvanized clam and oyster racks", to give only one example. Non-English language references, "no date provided" references, etc., are numerous. Applicant is intimately aware, of the point of alleged novelty in this application and likewise is aware of the most pertinent prior art that is being presented during court proceedings. If such is present in the voluminous prior art statements submitted, he has the duty to it point out. A prior art statement is intended to include "pertinent" prior art. Only one illuminating hint has been given the Examiner, in the IDS of 6/15/06. If there is specific evidence supporting Pella's assertion that Applicant knew of the use of TWP screen in fenestration units, such must be provided or otherwise pointed out. Likewise, any specific information supporting the statement by expert witness Bruce Stoner is also required.

Applicants regret the burden on the Examiner caused by the necessity that these materials be cited. Most of the items listed in the IDSs either were presented to Applicants by opposing parties during the litigation styled Andersen Corporation v. Pella Corporation and W.L. Gore & Associates, Inc., which involves the '612 Patent, or were from the litigation itself. Applicants do not admit that any of the items listed on the IDSs are material. In fact, Applicants likewise have been unable to ascertain whether a number of the items provided by opposing parties qualify as

prior art or even if they are pertinent to the disclosed invention. Opposing parties in the litigation have asserted that many of these items qualify as prior art or are pertinent, but have yet to provide supporting information, including information such as that requested in the Final Office Action. Further, although Applicants do not concur, since opposing parties assert that these materials are pertinent and material, Applicants have little choice but to cite them pursuant to MPEP § 2001.06(c) and § 609 and pursuant to 37 C.F.R. § 1.56, specifically subsection (d). Applicants endeavored to arrange and present the IDSs to the Office in a manageable format rather than forwarding a mass of unorganized materials, such as provided by opposing parties in the litigation. Although the Final Office Action dated September 12, 2006 states that many “references are web sites that do not qualify as prior art since no date is provided other than the date they were printed off the internet,” Applicants point out that several items have multiple dates, including copyright dates, purported uploading dates, and printing dates. Although Applicants prefer and request that the Examiner consider and initial all items provided, Applicants have not been provided, nor are they aware, of more pertinent dates than already provided for, or recited in, any item listed on any of the filed IDSs.

The Final Office Action requested that if “there is specific evidence supporting Pella's assertion that Applicant knew of the use of TWP screen in fenestration units, such must be provided or otherwise pointed out. Likewise, any specific information supporting the statement by expert witness Bruce Stoner is also required.” Since Applicants continue to dispute that such purported “knowledge” ever existed, Applicants cannot provide any additional information of this supposition. Pella has also failed to provide any additional specific information supporting the statement by expert witness Bruce Stoner. Applicants are aware of their continuing duty to provide all information material to the patentability of the present claims and have endeavored to

provide all information for the Examiner's consideration, including information the Applicants deem may be material, information the Applicants believe the Examiner may deem material, and information third parties allege or deem are material.

The Examiner is requested to contact the below listed attorney if prosecution can be advanced in any manner.

Housekeeping issue:

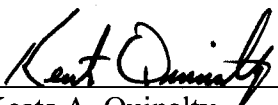
On April 31, 2005, the Examiner signed sheets 1 and 2 of an IDS filed August 27, 2004, but failed to initial any of the items 1-5 listed on sheet 1. Applicants request that the Examiner indicate consideration of such items by initialing each in the space provided. If requested, Applicants will re-file the IDS filed August 27, 2004 or will provide additional copies of the cited items for consideration.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees that may be required for consideration of this Request for Reconsideration, or credit any overpayment, to Deposit Account No. 09-0528.

Date: 10/23/06

Respectfully submitted,



Keats A. Quinalty
Reg. No. 46,426
Attorney for Applicants

Customer ID No.: 26158
Womble Carlyle Sandridge & Rice, PLLC
P.O. Box 7037
Atlanta, GA 30357-0037
Telephone: (404) 879-2423
Facsimile: (404) 879-2923
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